



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,478	11/13/2000	Brian A. Vulpitta	MA-12957	7902

7590

01/16/2004

FAY, SHARPE, FAGAN, MINNICH & McKEE, LLP
1100 SUPERIOR AVENUE, SEVENTH FLOOR
CLEVELAND, OH 44114-2518

EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,478

Applicant(s)

VULPITTA ET AL.

Examiner

Jane J Rhee

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1772

DETAILED ACTION

Rejections Withdrawn

1. The 35 U.S.C. 102 rejection of claims 1-5,11-15 anticipated by Schonhorns et al. made of record in paragraph 1 of Paper 18 have been withdrawn due to applicant's amendment in Paper 19.

Rejections Repeated

2. The 35 U.S.C. 103 rejection over Schonhorns in view of Martin-Cocher et al. has been repeated for the reasons previously made of record in paragraph 2 of Paper 18.

New Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5,5-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Schonhorns (0430548).

Schonhorns et al. discloses an adhesive tape product comprising a hollow cylindrical core (figure 5 number 10) having a diameter and a width, and an outer surface a compressible foam strip surrounding the core (figure 5 number 60), and a length of adhesive tape having a uniform width and a length substantially greater than the width wound in several forms about the core and the foam strip (col. 5 lines 9-12). Schonhorns et al. discloses that the foam strip surrounding the core in a single layer

Art Unit: 1772

has a total thickness of 1mm (col. 5 line 14). Schonhorns et al. discloses that the core comprises a thin solid tubular wall (figure 5 number 10). Schonhorns et al. fail to disclose a length of adhesive tape comprising three portions; a leader portion fixed to the core, a foam support portion and a useable tape portion wherein a foam strip is fixed to the tape foam support portion, however, Schonhorns et al. teaches that the adhesive on the core serves as the equivalent function of the leader portion and the foam support portion for the purpose of providing an attachment means of the foam to the core (col. 5 lines 4-6). Furthermore the foam and the tape taught by Schonhorns et al. is the equivalent function of the foam strip and usable tape portion wherein the usable tape portion is adhered and wrapped around the foam as desired by the applicant wherein the invention produces a collapsible effect by enveloping the outer surface of a non severed core with foam (col. 4 lines 56-col. 5 line 1).

Therefore, it would have been obvious to one with ordinary skill in the art at the time applicant's invention was made to provide Schonhorns et al. with a length of adhesive tape comprising three portions; a leader portion fixed to the core, a foam portion and a useable tape portion wherein a foam strip is fixed to the tape foam support portion in order to provide a collapsible effect by enveloping the outer surface of a non severed core with foam (col. 4 lines 56-col. 5 line 1) as desired by the applicant since Schonhorns et al. teaches the equivalent function of applicant's anti-telescoping adhesive product.

Response to Arguments

Art Unit: 1772

4. Applicant's arguments filed 5/14/03 have been fully considered but they are not persuasive.

In response to applicant's argument that Martin-Cocher is not analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Martin-Cocher teaches a barrel shaped core/spool wherein film is wrapped around the core/spool, applicant has an adhesive tape wrapped around a core. Martin-Cocher teaches the general concept of a material that is wrapped around a core, which is considered to be in the field of applicant's endeavor.

In response to applicant's argument that Schonhorn and Martin-Cocher does not teach the combination because Martin Cocher teaches stretching of a film in different amounts across its width, Martin-Cocher teaches a barrel shaped core/spool wherein film is wrapped around the core/spool, applicant has an adhesive tape wrapped around a core. Martin-Cocher teaches the general concept of a material that is wrapped around a core, which is considered to be in the field of applicant's endeavor, therefore, it is appropriate to combine the two references since similar general concept of a material wrapped around a core is shared.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Ahmad can be reached on 571-272-1487. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9344 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

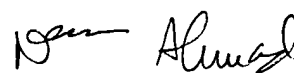
Application/Control Number: 09/711,478

Page 6

Art Unit: 1772

A handwritten signature in cursive script, appearing to read "Jane Rhee".

Jane Rhee
January 12, 2004

A handwritten signature in cursive script, appearing to read "Nasser Ahmad".

NASSER AHMAD
PRIMARY EXAMINER